

**REMARKS**

Claims 39-56 are pending in the present application. In the Office Action mailed October 31, 2007, the Examiner rejected claims 49-52 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner next rejected claims 39-44 and 49-52 under 35 U.S.C. §102(e) as being anticipated by Albrecht et al. (USP 6,977,358).

Claims 53-56 are allowed. Claims 45-48 were indicated as containing allowable subject matter. Such indication is appreciated.

Claim 45 was objected to by the Examiner and has been amended to correct a typographical error therein.

**Rejections under 35 U.S.C. §112**

The Examiner rejected claims 49-52 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In making the rejection, the Examiner cites MPEP § 2173.05(d), and states that “the phrase ‘or the like’ (in this instance, the term ‘type’) renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed..., thereby rendering the scope of the claim(s) unascertainable.” *Office Action*, October 31, 2007, p. 2. Applicant respectfully disagrees with the Examiner’s assertion that the aforementioned claims are indefinite because of the inclusion of the term “welding-type.”

The Examiner’s misconception regarding the inclusion of the term “welding-type” in a claim, and its affect on the definiteness of those claims, has already been corrected by the BPAI in an Appeal previously filed by Applicant that involved the present Examiner.<sup>1</sup> In that Appeal, the BPAI stated that “[t]he Federal Circuit has explained that ‘[i]f [a] claim is subject to construction, i.e., it is not insolubly ambiguous, it is not invalid for indefiniteness’” and that “[i]t is [ ] hornbook patent law that during patent examination ‘the PTO applies to the verbiage of the claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.’” *Decision on Appeal*, January 11, 2008, p. 13 and 15 (citing *Bancorp Services, L.L.C. v. Hartford Life Insurance Co.*, 359 F.3d 1367, 1371 (Fed. Cir. 2005) and *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997)).

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<sup>1</sup> For application Serial No. 10/249,018, *See Decision on Appeal*, January 11, 2008, p. 13-15.

In the present case, and regarding claim 49, the Examiner has provided no explanation as to how the term “welding-type device,” which occurs in the body of claim 49, is “insolubly indefinite.” In fact, the BPAI in the aforementioned Appeal specifically stated that “as long as a given power supply can provide enough power to weld any sort of material, the ‘welding-type power’ and ‘welding-type power supply’ limitations are met.” *Decision on Appeal*, supra at 15. A similar type of construction must be applied to the term “welding-type device” in the present claims, as one skilled in the art would understand what is claimed in claims 49-52 when the claims are read in light of the specification. Evidence to support this conclusion is set forth in the specification, where ¶1 describes a “welding-type” apparatus or device as “any system that requires high power outputs that can benefit from the use of a compressed shielding gas” and that “[s]uch systems can include heating and cutting systems.”

Furthermore, and with regards to claim 51, the term “welding-type” is present only in the preamble of the claim. In the above mentioned Appeal, the BPAI indicated that with respect to the term “welding-type,” “[i]t is only when terms in the preamble ‘give life and meaning to the claim’ that they are given patentable weight.” *Decision on Appeal*, supra at 14. In the present case, the Examiner has not identified any limitations recited in the body of claim 51 that refer back to the term “welding-type” in the preamble or rely on that term in such a way that the term “welding-type” constitutes or explains any of the subsequent limitations. As such, the rejection of claim 51 under §112 based solely on its inclusion of the term “welding-type” is improper and the rejection should be withdrawn.

In light of the foregoing, Applicant believes that claims 49-52 comply with the requirements of 35 U.S.C. §112, and as such, respectfully requests withdrawal of the rejection thereof.

#### **Rejections under 35 U.S.C. §102(e)**

The Examiner rejected claim 39 under 35 U.S.C. §102(e) as being anticipated by Albrecht et al. While Applicant does not necessarily agree with the rejection, Applicant has nonetheless elected to amend claim 1 to further clarify what is being called for therein. As amended, claim 1 calls for, in part, a welding device including a suitcase housing having a shape to compactly enclose a power source constructed to supply a welding power, the suitcase housing including a pair of connected side shells hinged together to enclose the power source.

Albrecht et al. does not specifically teach such a welding device. Albrecht et al. discloses a welding device 10 that includes a gas cylinder 34, a wire feeder 52, and a power source 54 disposed in an interior 50 of housing 12 of the welding device 10. *Albrecht et al.*, Col. 5, lns. 2-4.

Albrecht et al., however, does not specifically disclose a suitcase housing having two connected side shells and a shape to compactly enclose the wire feeder. As can be seen from Fig. 1 of the cited reference, the housing 12 of welding device 10 is clearly not a suitcase housing having two connected side shells as called for in claim 39. While cover 14 and door 28 of welding device 10 are hinged together, they do not form a pair of side shells having equal outer perimeters that are hinged together to enclose the power source. *See Albrecht et al.*, Fig. 1.

As such, Applicant believes that claim 39, and the claims dependent therefrom, cannot be anticipated by Albrecht et al. under §102, and since the reference is commonly owned, it does not qualify as a §103 reference.

The Examiner rejected claim 49 under 35 U.S.C. §102(e) as being anticipated by Albrecht et al. Applicant has elected to amend claim 49 to further clarify what is being called for therein. Claim 49 calls for, in part, a method of providing shielding gas to a weld including opening a shielding gas path to a gas system and providing shielding gas immediately upon connection of a gas source to a welding-type device, wherein opening the shielding gas path includes positioning an adapter having a threaded recess therein adjacent to a threaded section on the gas source. The step of opening the shielding gas path also includes rotating the gas source to engage the threaded section of the gas source with the threaded recess, wherein the engaging of the threaded section with the threaded recess causes a nipple positioned on the adapter to actuate a valve positioned on the gas source and provide a flow of the shielding gas.

Albrecht et al. does not teach or suggest such a method for providing shielding gas to a weld. Albrecht et al. discloses a welding device 10 that includes a gas cylinder 34, a wire feeder 52, and a power source 54 disposed in an interior 50 of housing 12 of the welding device 10. *Albrecht et al.*, Col. 5, lns. 2-4. An outlet end 64 of gas cylinder 34 is constructed to engage a first adapter 66 of a regulator 68 such shielding gas is delivered from the gas cylinder upon connection thereof to the welding-type adapter and regulator. *Albrecht et al.*, Col. 3, lns. 54-56.

Albrecht et al., however, does not teach or suggest that which is called for in claim 49. That is, while Applicant does not necessarily disagree that Albrecht et al. teaches a gas cylinder that provides shielding gas upon engagement with the welding device 10, there is no teaching or disclosure in Albrecht et al. of a threaded engagement between gas cylinder 34 and adapter 66 or of an automatic actuation of a valve in the gas cylinder caused by a nipple on the adapter as called for in claim 39. As Albrecht et al. does not teach or disclose engaging of a threaded section on a gas cylinder with a threaded recess in an adapter to cause a nipple positioned on the adapter to actuate a valve positioned on the gas source and provide a flow of the shielding gas, claim 49 and

the claims dependent therefrom cannot be rejected over the cited reference under §102. Furthermore, since the reference is commonly owned, it does not qualify as a §103 reference.

The Examiner rejected claim 51 under 35 U.S.C. §102(e) as being anticipated by Albrecht et al. Applicant has elected to amend claim 51 to further clarify what is being called for therein. As amended, claim 51 calls for, in part, a welding-type device including a suitcase enclosure to compactly enclose means for generating a welding power and means for providing shielding gas, the suitcase enclosure including a pair of connected side shells having equal outer perimeters and being hinged together. As set forth above with respect to claim 39, Albrecht et al. simply does not teach or disclose a welding-type device including a suitcase enclosure. Instead, Albrecht et al. discloses a housing 12 that includes a side-cover 14 having a door 28 that covers an opening 30 therein. *See Albrecht et al.*, Fig. 1. This cover 14 and door combination 28 is not what is called for in claim 51, which sets forth that the pair of connected side shells have equal outer perimeters that are hinged together. As Albrecht et al. does not teach or disclose all the elements of claim 51, it does not anticipate claim 51 under §102(e), and since the reference is commonly owned, it does not qualify as a §103 reference.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 39-56.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,

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**General Authorization and Extension of Time**

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-2623. Should no proper payment be enclosed herewith, as by credit card authorization being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-2623. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extensions under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-2623. Please consider this a general authorization to charge any fee that is due in this case, if not otherwise timely paid, to Deposit Account No. 50-2623.

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